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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/654,733

Applicant(s)

WILLIAMS, EMRYS J.

Examiner

CHARLES C. AGWUMEZIE

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-10, 12-31, 33-37 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-10, 12-31, 33-37 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/22/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment

1. Applicants' argument/amendment filed January 21, 2009 is acknowledged. Accordingly claims 1-10, 12-31, 33-37, and 39 remain pending.

Response to Arguments

2. Applicant's arguments, see remarks, filed January 21, 2009, with respect to provisional election/restriction requirement have been fully considered and are persuasive. The restriction requirement of groups II and III has been withdrawn.
3. Applicant's arguments filed January 21, 2009 with respect to the Section 103(a) rejection have been fully considered but they are not persuasive.
4. With respect to **claim 1**, Applicant argues that the cited art fails to teach or suggest wherein the apparatus is operable to: receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility, generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers; and transmit the transaction record to the terminal through the communications_facility. That the details described by the cited art do not include "a particular identifier selected by the processor from said set of multiple identifiers."

In response Examiner respectfully disagrees and submits that Pitroda does disclose an apparatus operable to: receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility, generate

a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers; and transmit the transaction record to the terminal through the communications facility. Pitroda specifically discloses American Express card as the identifier which is selected from the set of multiple identifiers (see 0089; 0100, which discloses "transmits completed details of the sales transaction to the point of sales computer, the UET card, and the American Express service... the details include the date of the transaction, the amount, the name of the retail store or service (for the UET card and the American Express service records), the name of the customer (for the American Express and point of sales computers). Is American Express not an identifier? Is the American Express card not selected from the Universal Electronic card (UET)? Is the UET not used to store multiple identifier or cards? It is Examiner's position that Pitroda does disclose the claimed limitation as shown in the rejection.

5. Furthermore, Applicant is reminded that in a claim construction regarding "wherein/whereby" clauses, according to the MPEP, "'whereby clause in an apparatus claim is not given weight when it simply expresses the intended result or use of a process step positively recited" (*Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003))". Also, a (whereby/wherein) clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747

Art Unit: 3685

(CAFC 2001)). Also limitation wherein the apparatus is operable to: ..., this is non-functional descriptive material which does not further limit the claimed apparatus and can also be omitted.

6. Applicant further argues that the Examiner has not stated a proper reason as to why one of ordinary skill in the art would have combined the teachings of the cited references to create Applicant's invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Walker and Pitroda disclose transaction cards that are operable to select an identifier from among multiple identifiers. Moreover, the Examiner notes that *KSR* forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396.

7. With respect to claims 9 and 26, Applicant argues that the remarks with respect to claim 1 apply to claims 9 and 26.

In response, Examiner asserts that the argument with respect to claim 1 above also applies to claim 9 and 26 including their respective dependent claims.

Election/Restrictions

8. The restriction requirement of group I, claims 1-8, 9-14, and 26-29 with traverse, as set forth in the Office action mailed on October 20, 2008, has been reconsidered in view of the Applicant's argument filed January 21, 2009. The restriction requirement is hereby withdrawn because Applicant argues that invention II comprising claim 16 and invention III comprising claims 15, 17-25, 30-35, 36-37 and 39 are not patentably distinct from invention I. Accordingly inventions II and III are rejected on the same rationale as invention I.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claim 14**, is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it would be unclear to one of ordinary skill in that art to understand the technical meaning of "limiting the number of transactions performed during a given period of time in order to prevent rapid readout of the

Art Unit: 3685

identifiers." How does the apparatus perform this operation in the first place? Is it when the apparatus is being used or what or does the identifiers evaporate or melt?

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-2, 5, 7-10, 13, and 26-29**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent Application Publication No. 2006/0218098 A1 in view of Pitroda U.S. Patent Application No. 2005/0247777A1.

13. As per **claims 1, 9, and 26**, Walker et al discloses an Apparatus for use in transactions, comprising:

non-volatile memory containing a set of multiple identifiers associated with a same customer account, wherein said multiple identifiers are also known to an agency providing said customer account (fig. 1; 0025; 0026; "...plurality of predetermined single-use financial account identifiers..."), and

a processor operable to select for each of a plurality of transactions involving the same customer account, a different identifier from said set of multiple identifiers for use with the respective transaction (fig. 1; 0023; 0047; 0049; "...the encryption data

Art Unit: 3685

changes for each use of the card so that ... card number is different for each transaction...") and

a communications facility operable to communicate with a terminal (0004; ...wireless connection...; 0047; cardholder transmits the single use number to merchant...;);

wherein the apparatus is operable to:

receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility,

generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers; and

transmit the transaction record to the terminal through the communications facility (figs. 3 and 4; 0045; 0047; "...transmits the single use number to the merchant...").

14. What Walker et al does not explicitly disclose is:

wherein the apparatus is operable to:

receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility,

generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers; and

transmit the transaction record to the terminal through the communications facility.

15. Pitroda discloses an apparatus for use in transaction comprising:

receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility (0089, which discloses that the point of sales computer will download and display the transaction details, as shown in FIG. 16, and transmit the transaction information into the memory of the UET card, on which the transaction information may be displayed for visual verification by the customer; 0100);

generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers (0089; 0100, which discloses "transmits completed details of the sales transaction to the point of sales computer, the UET card, and the American Express service... the details include the date of the transaction, the amount, the name of the retail store or service (for the UET card and the American Express service records), the name of the customer (for the American Express and point of sales computers); and

transmit the transaction record to the terminal through the communications facility (0100, which discloses transmits completed details of the sales transaction to the point of sales computer).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, wherein the apparatus is operable to: receive bill details for a given transaction of said plurality of transactions from the terminal through the

communications facility, generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers; and transmit the transaction record to the terminal through the communications facility in view of the teachings of Pitoda in order to facilitate transaction and ensure record keeping and in addition, since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

16. As per **claim 2, and 10**, Walker et al further discloses the apparatus, wherein each of the identifiers in said set of multiple identifiers is allocated by the agency uniquely to the apparatus (figs. 1 and 10; 0049; 0093; "...instructing card holder to obtain a new device with list of single-use credit card numbers...").

17. As per **claim 5 and 13**, Walker et al further discloses the apparatus, wherein the transaction record is encrypted (0009; 0023).

18. As per **claim 7**, Walker et al further discloses the apparatus, wherein said apparatus is operable to engage a first class of terminals external to the apparatus for making a transaction, and a second class of terminals external to the apparatus to enter or to update account information stored in the non-volatile memory (fig. 3 and 4; 0093).

19. As per claim 8, Walker et al failed to explicitly disclose the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory.

Pitroda discloses the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory (see figs. 3; 0014).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory in view of the teachings of Pitroda since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

20. As per **claim 27**, Walker failed to explicitly disclose the method, wherein the transaction record includes a digital signature from the transaction device.

Pitroda discloses the method, wherein the transaction record includes a digital signature from the transaction device (0089; 0100)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the method, wherein the transaction record includes a digital signature from the transaction device in view of the teachings of Pitroda in order to ensure security and in addition since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

21. As per **claim 28**, Walker further discloses the method, wherein the transaction device is associated with a customer account, and wherein said multiple identifiers are also known to an agency providing said customer account, but failed to explicitly disclose the method further comprising:

- transmitting the transaction record from the terminal to an agency computer;
- accessing an account record for the customer account based on the selected identifier included in the transaction record;
- validating the transaction and
- updating the account record in respect of the validated transaction.

Pitroda discloses the method further comprising:

transmitting the transaction record from the terminal to an agency computer (0100, which discloses the CIU transmits completed details of the sales transaction to the point of sales computer, the UET card, and the American Express service);

accessing an account record for the customer account based on the selected identifier included in the transaction record (0100);

validating the transaction (0099; 0100) and

updating the account record in respect of the validated transaction (0099; 0100).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus comprising, transmitting the transaction record from the terminal to an agency computer; accessing an account record for the customer account based on the selected identifier included in the transaction record; validating the transaction and updating the account record in respect of the validated transaction in view of the teachings of Pitroda in order to facilitate transaction and ensure security and in addition since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

22. As per claim 29, Walker failed to explicitly disclose the method, wherein prior to transmitting the transaction record from the terminal to the agency computer, the terminal incorporates its own copy of the bill into the transaction record.

Pitroda discloses the method, wherein prior to transmitting the transaction record from the terminal to the agency computer, the terminal incorporates its own copy of the bill into the transaction record (0089; 0100).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Wynn and incorporate the method, wherein prior to transmitting the transaction record from the terminal to the agency computer, the terminal incorporates its own copy of the bill into the transaction record in view of the teachings of Pitroda in order to ensure accurate record and in addition since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

23. Claims 4 and 12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent Application Publication No. 2006/0218098 A1 in view of Pitroda U.S. Patent Application No. 2005/0247777A1 and further in view of Ritter et al U.S. Patent No. 6,934,689.

24. As per claim 4 and 12, both Walker et al and Pitroda failed to explicitly disclose the apparatus, wherein the transaction record includes a digital signature that is generated using a cryptographic key contained within the non-volatile memory.

25. Ritter et al discloses the apparatus, wherein the transaction record includes a digital signature that is generated using a cryptographic key contained within the non-volatile memory (col. 2, line 60- col. 3, line 10, which discloses that the payment request of the payment transaction being transmitted from the payment terminal to the mobile device taking part in the respective payment transaction ... a payment record being prepared in the mobile device in that the payment is linked to a customer identification ... for example is provided with an electronic signature of the customer or is executed as a secured certificate ... the payment record being transmitted from the mobile device to the payment terminal ...).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, wherein the transaction record includes a digital signature that is generated using a cryptographic key contained within the non-volatile memory in view of the teachings of Ritter in order to ensure security and in addition since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable

26. Claims 6, is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent Application Publication No. 2006/0218098 A1 in view of Pitroda U.S. Patent Application No. 2005/0247777A1 and further in view of Palomo et al U.S. Patent Publication No. 2003/0120527 A1.

27. As per claim 6, both Walker et al and Pitroda failed to explicitly disclose the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body.

Palomo et al discloses the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body (0025, which discloses that '741 patent describes a computer system and method for storage of individual medical histories ... the size of which is that of a credit card including the possibility of implanting the storage device under the skin of the patient's upper torso).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body as taught by Palomo et al in order to ensure security and in addition since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

28. Claims 15, 16, 17-25, 30-31, 33-35, 36-37 and 39, are similarly rejected on the same rationale as claims 1-8, 9-10, 12-14 and 26-29.

Conclusion

29. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed

Art Unit: 3685

invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Charles C.L. Agwumezie** whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685
March 24, 2009